

REMARKS/ARGUMENTS

Claims 35-42 and 44-78 are pending. By this amendment, claims 35, 42 and 46 are amended, claim 43 is canceled and new claims 77 and 78 are added.

The Office Action rejects claims 35-41 and 49-57 and 69-76 under 35 USC 112, second paragraph. This rejection is respectfully traversed.

Claims 35 and 42 recite a covering arrangement suitable for covering a water tank (claim 35) or a component of an air conditioning system (claim 42) which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building, and an adjustable angular positioning device being configurable so as to keep said tank (or component) in a substantially vertical position. The water tank (claim 35) and component of an air conditioning system (claim 42) are not elements of the claims. Instead, the covering arrangement is recited as being suitable for covering a water tank or a component of an air conditioning system. Likewise, the adjustable angular positioning device is recited as being configurable so as to keep said tank in a substantially vertical position. Further, the recitation of and/or in claim 76 is not inherently indefinite as it covers three situations: 1) the external portion of the building; 2) the architectural style of the building; and both 1) and 2). Accordingly, the claims are not indefinite and withdrawal of the rejection is requested.

The Office Action rejects claims 35-49 under 35 USC 102(e) over Garrett (US Pat. 6,926,241). This rejection is respectfully traversed.

Garrett discloses accessories for use in pitched roof construction. As illustrated in Figs. 12-26 for example, Garrett discloses a material and supply support having a main support table

1, which may have a lip on the outboard side of the apparatus. Main support bars 2 may be provided in a slidable fashion on connecting rods 4 and 5. See col. 22, lines 19-35. The main support table 1 is provided with angle adjustment to compensate for different roof pitches. Fig. 21 illustrates the material and supply support holding a water jug and Fig. 22 illustrates it holding a cooler. See col. 24, lines 7-12.

However, independent claim 35 of the application recites “a covering arrangement suitable for covering a water tank which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building.” Likewise, independent claim 42 recites “a covering arrangement suitable for covering a component of an air-conditioning system which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building.”

The Office Action refers to a tarp in Garrett at col. 22, lines 15-19 as the covering arrangement, where Garrett refers to a custom tarp used to cover materials, stating:

“The addition of fourteen inch safety rails prevents materials such as tile and slate from falling off the roof. The platform easily adjusts to roof truss layouts of two feet, 18-inch and 16 inch on center, as well as other dimensions. The ROOFSTOCKER™ increases safety for employees and customers and decreases liability to the contractor. A custom tarp may be made to cover materials on the ROOFSTOCKER™ Standard size in the preferred embodiment is 54" in length and 42" in width.”

Garrett does not disclose or suggest a covering arrangement suitable for covering a water tank (or a component of an air-conditioning system) and being made in the shape of an architectural component of the building, as recited in claims 35 and 42. The tarp of Garrett is not a covering arrangement being made in the shape of an architectural component of the building.

Instead, it is a tarp used to temporarily cover materials. The tarp is not made in the shape of an architectural component of the building, but is instead merely a flat tarp. Further, a tarp placed over a water tank will not be a covering arrangement suitable for covering a water tank (or a component of an air-conditioning system being made in the shape of an architectural component of the building, but instead the tarp will take the shape of the component it covers.

As disclosed in the specification (and recited in dependent claims), architectural components of the building may include, e.g., a chimney cap, a skylight, an attic skylight, verandas or balconies. See page 10, lines 20-27, for example. The architectural components are selected to hide the water tank or component of an air-conditioning system from view, and to harmonize the covering arrangement with the building and with the architectural style of the building itself.

For the above reasons, Garrett does not anticipate independent claims 35 or 42, or dependent claims 36-41 and 43-49. Withdrawal of the rejection is requested.

The Office Action rejects claims 35, 37, 42-44, 49-51 and 69-75 under 35 USC 102 over Wilhelmson (U.S. Pat. 6,093,098). This rejection is respectfully traversed.

Claim 35 recites an adjustable angular positioning device being configurable so as to keep said tank in a substantially vertical position. Claim 42 recites an adjustable angular positioning device being configurable so as to keep said component of an air-conditioning system in a substantially vertical position. Wilhelmson does not disclose an adjustable angular positioning device. Wilhelmson has no disclosure that the platform 28 is an adjustable angular positioning device. Accordingly, claims 28 and 42, and dependent claims 37, 49-51 and 69-75 are not anticipated by Wilhelmson. Withdrawal of the rejection is requested.

The Office Action rejects claims 50-57 and 76 under 35 USC 103 over Garrett. This rejection is respectfully traversed.

The Office Action asserts that it would have been an obvious matter of design choice to form the architectural component as any type of decorative design, as such a change would have involved a mere change in shape of a component. The Office Action cites *In re Dailey*, 149 USPQ 47 (CCPA 1996) for the assertion that a change in shape is generally recognized as being within the level of ordinary skill in the art.

However, in *In re Dailey*, both the claimed invention and the prior art applied by the Examiner concerned a nursing container for infants, where the claimed invention (claims 27 and 28) differed from the prior art in the recitation of a “less than a hemisphere” configuration. The Court found that no convincing argument was presented that “the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container.” *Id* at 49-50.

Claim 50 of the present application recites “Apparatus according to claim 35, wherein said architectural component has a shape selected from a group comprising: a chimney cap, a skylight, an attic skylight, a veranda, a balcony, a column, and an arch.” Garrett merely discloses a tarp for covering roofing items used by construction workers. In contrast to *In re Dailey*, the claimed invention of a covering arrangement in the shape of an architectural component of a building does not concern a same type of structure as the prior art. In particular, the claimed covering arrangement in the shape of an architectural component of a building is distinct from a flat tarp. Further, the claimed covering arrangement in the shape of an architectural component of a building provides significant advantages over a tarp, in that it hides

the water tank or component of an air-conditioning system from view, and/or it harmonizes the covering arrangement with the building and/or with the architectural style of the building itself.

Moreover, the Board of Patent Appeals and Interferences has held that a claimed shape (chips) is important because it results in a product which is distinct from the reference product (french fries). *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965). The claimed covering arrangement in the shape of an architectural component of a building results in a product distinct from a tarp, and the claimed architectural component having a shape selected from a group comprising: a chimney cap, a skylight, an attic skylight, a veranda, a balcony, a column, and an arch, as recited in claim 60, is also distinct from a tarp.

The wall arrangement, window, grille, building bricks, and panel elements of claims 51-55 are also asserted by the Office Action to be a matter of design choice. The claimed wall arrangement, window, grille, building bricks, and panel elements of claims 51-55 also result in a product distinct from a tarp as disclosed in Garrett. The Office Action points to no teaching as to why it would be obvious to modify a tarp to result in any of these claimed elements.

Regarding claim 76, it is submitted that the Office Action has failed to make a *prima facie* case of obviousness. In particular, claim 76 recites the elements in means-plus-function language. The Office Action has failed to properly analyze the claims under 35 USC 112, par. 6. In particular, the Office Action has failed to identify the claimed function and the structure in the specification that performs the claimed function, and has failed to determine whether the asserted prior art performs the identical function, and if so whether structure in the asserted prior art that performs the function is the same or equivalent to the structure disclosed in the specification. It is respectfully asserted that even if Garrett discloses the same function recited in the elements of

claim 76 (which Applicants do not admit to), Garrett does not disclose at least the same or equivalent structure of any of the elements of claim 76.

For the above reasons, and because claims 50-57 depend from claim 35, Garrett does not render obvious claims 50-57. Withdrawal of the rejection is requested.

The Office Action rejects claims 58-60 and 68 under 35 USC 103 over Soloman (US Pat. 5,989,656) in view of Blue Hill Avenue. This rejection is respectfully traversed.

Soloman discloses container covers with foliage which function to give an aesthetic appearance to landscape having containers (emphasis added). See col. 1, lines 6-9. The covers comprise a net cover 12 with a plurality of foliage 16 attached to the net cover. The foliage is selected to conform to the natural surroundings of the container to give a natural aesthetic appearance. See col. 4, line 53 through col. 5, line 17.

Soloman does not disclose that the covers are used to cover an element disposed on a building as asserted in the Office Action. Instead, the covers are used to cover containers on landscape having exposed containers. That is why the covers utilize foliage 16. Further, Soloman does not disclose applying said layer element onto a supporting surface element surrounding a functional non-architectural element, the functional non-architectural element being disposed on the building. The containers of Soloman are not part of a building, but are instead part of landscape.

Blue Hill Avenue merely discloses painting murals on windows of abandoned buildings. One of ordinary skill in the art would not have combined the covers with foliage used to cover exposed containers on landscape of Soloman with murals painted on windows of abandoned buildings of Blue Hill Avenue. Accordingly, claims 58-60 and 68 would not have been obvious over Soloman in view of Blue Hill Avenue. Withdrawal of the rejection is requested.

The Office Action rejects claims 58-65 under 35 USC 103 over Drew (US Pat. 3,742,659) in view of Cherkas (US Pat. 5,858,494). This rejection is respectfully traversed.

The Office Action asserts that Drew discloses a building with a functional, non-architectural element with a cover, but admits that Drew does not disclose any of the claimed steps recited in claim 58. The Office Action asserts that it is notoriously well known that items can be decorated, that such decoration can comprise reproducing a selected part of an original to get an image therefrom onto a layer element, and then applying the layer element onto a support surface element. The Office Action cites Cherkas as disclosing decorating a lure by reproducing a selected part of an original (fish) to get an image on a layer element and then applying the layer element onto a support surface (lure). The Office Action asserts that it would have been obvious to modify Drew to use the method of creating decoration of Cherkas in order to better disguise and blend in the architectural element.

Cherkas is non-analogous art. The customizing of a fishing lure of Cherkas is not the same field of endeavor as the claimed invention (mounting of a functional, non-architectural element onto a building), and Cherkas does not deal with the same problems that were confronted by the inventor, harmonizing the functional, non-architectural element mounted on a building with an external portion of the building. Further, even if Cherkas qualifies as analogous art, which it does not, the Office Action provides no motivation as to why one of ordinary skill in the art of mounting equipment on a roof as in Drew would look to the art of fishing lures of Cherkas. As such, one of ordinary skill in the art would not look to decals for fishing lures when considering equipment mounted on a roof as in Drew.

For the above reasons, it is submitted that the rejection of the claims as obvious over Drew in view of Cherkas is improper. Withdrawal of the rejection is requested.

The Office Action rejects claims 66-67 under 35 USC 103 over Drew in view of Cherkas and further in view of Garrett. This rejection is respectfully traversed.

Claims 66-67 would not have been obvious over the applied references due to claims 66-67 dependence from claim 58, and because Garrett does not solve the deficiencies of Drew and Cherkas noted above regarding claim 58. Withdrawal of the rejection is requested.

New claims 77 recites that the adjustable angular positioning device includes a bottom face adapted to be positioned against a roof of the building in use, and a support surface for the tank, the support surface being adjustable relative to the bottom surface. New claim 78 recites that the adjustable angular positioning device includes a bottom face adapted to be positioned against a roof of the building in use, and a support surface for the component of an air-conditioning system, the support surface being adjustable relative to the bottom surface. These claims are believed to be allowable over the applied references.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the below listed telephone number.

STRASSO
Appl. No. 10/562,199
October 20, 2010

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-5516-2.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Paul T. Bowen/
Paul T. Bowen
Reg. No. 38,009

PTB: DJZ
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100